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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,721	04/10/2001	Glenn R. Smith	IBM 2 0004	8452

7590

08/24/2004

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/829,721	Applicant(s) SMITH ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4/10/01</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 4/10/2001.
2. Claims 1-20 are pending in the case, claims 1, 8 and 17 are independent claims.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

- Reference character "66" in Figures 4(b) and 4(c) has been used to designate both a "*text entry dialog box*" (page 10, line 11) and "*text*" (page 11, line 3).
- Reference character "68" in Figure 4(b) has been used to designate both a "*text entry space*" (page 10, line 11) and "*cursor*" (page 11, line 5).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following figures or reference sign(s) mentioned in the description:

- "Figure 1(a)" on page 3, line 21.
- "Figure 1(b)" on page 3, line 23.

- "Figure 1(c)" on page 4, lines 1 and 4.
- "Figure 1(d)" on page 4, line 5.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "67" in Figure 4(b).

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:
- The disclosure recites "*drop-down arrow button 50*" (page 5, line 16) in reference to Figure 3(a). Reference sign 50 of Figure 3(a) is directed toward a "*drop-down combination box*" (page 5, line 14).
 - The disclosure recites those figures or reference signs listed in paragraph 4 above, which are not shown in the drawings.

- The disclosure fails to disclose those reference signs listed in paragraph 5 above, which are shown in the drawings.

Appropriate correction is required.

7. The use of the following trademarks has been noted in this application:

- "*Microsoft Windows*" on page 1, line 19.
- "*UNIX*" on page 1, line 19.
- "*Macintosh*" on page 1, line 20.
- "*Mac*" on page 1, line 20.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

9. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Word 2000, Copyright 1983-1999, Microsoft Corporation, Screen Printouts pages 1-2 (hereinafter MS Word).
10. **Regarding independent claim 1**, MS Word discloses a text entry dialog box system as shown in Figure 2, where the text entry space is shown on the right side of the dialog box shown. The text entry space allows for the free form entry of text by a user. Previously entered text items are stored in memory, as shown by the drop-down list shown below the text entry space in Figure 3. MS Word further shows in Figure 3, the selection button for the drop-down list being selectively displayed as the list contains items.
11. **Regarding dependent claim 2**, MS Word shows in Figure 3, the selection button for the drop-down list being selectively displayed as the list contains at least one item.
12. **Regarding dependent claim 3**, the claim is rejected for fully incorporating the deficiencies of their base claims.

13. **Regarding dependent claim 4**, MS Word discloses selectively displaying a list of previously entered text items in Figure 3, where the list is displayed under the text box on the right side of the figure.
14. **Regarding dependent claims 5 and 6**, MS Word discloses displaying the list of previously entered text items in a drop-down list as a result of selecting the selection button in Figure 3, where the selection button is shown as a button with a downward pointing arrow to the right of the text entry space.
15. **Regarding dependent claim 7**, the claim is rejected for fully incorporating the deficiencies of their base claims.
16. **Regarding independent claim 8**, MS Word discloses text input by a user into a dialog box in Figures 2-4. MS Word discloses a text entry section of a dialog box in Figures 2-4 on the right side of the figures. MS Word discloses counting the previously stored entries in Figure 3 (shown as the list with more than one entry on the right side of the figure) and displaying the list. MS Word discloses determining a user focus on the text entry section (shown as highlighted text in the text entry space). The user may edit the highlighted text as shown in Figure 4 (new text shown as "Bob"). The process may be repeated as desired.
17. **Regarding dependent claim 9**, MS Word discloses displaying the selection button when the count of the list is greater than zero in Figures 2-4, where figure 2 discloses no selection button (because the count value for the list is zero), and

figures 3 and 4 disclose the selection button (because the count value of the list is more than zero).

18. **Regarding dependent claim 10**, MS Word discloses accepting a typed text entry from the user when the user focus is directed to the text entry section in Figure 4.
19. **Regarding dependent claim 11**, MS Word discloses a list selection routine when the user focus is directed to the selection button in Figure 4.
20. **Regarding dependent claim 12**, MS Word discloses counting text entries with at least one character in Figures 3 and 4 (entries shown in the list examples have one or more characters).
21. **Regarding dependent claim 13**, MS Word discloses a user selection of an entry from the list in Figure 3.
22. **Regarding dependent claim 14**, the claim is directed toward a method for the system of claim 7, and is rejected using the same rationale.
23. **Regarding dependent claim 15**, the claim is directed toward a method for the system of claim 6, and is rejected using the same rationale.
24. **Regarding dependent claim 16**, the claim is directed toward a method for the system of claim 3, and is rejected using the same rationale.

25. **Regarding independent claim 17**, the claim is directed toward a method for the system of claims 1 and 2 combined, and is rejected using the same rationale.
26. **Regarding dependent claim 18**, the claim is directed toward a method for the system of claim 4, and is rejected using the same rationale.
27. **Regarding dependent claim 19**, the claim is directed toward a method for the system of claim 3, and is rejected using the same rationale.
28. **Regarding dependent claim 20**, the claim is directed toward a method for the system of claims 3 and 12 combined, and is rejected using the same rationale.

Conclusion

29. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,623,588	04-1997	Gould, Eric J.
• US-5,796,945	08-1998	Tarabella, Robert M.
• US-5,825,355	10-1998	Palmer et al.
• US-5,828,374	10-1998	Coleman et al.
• US-5,859,638	01-1999	Coleman et al.
• US-6,061,063	05-2000	Wagner et al.
• US-6,177,938	01-2001	Gould, Eric Justin
• US-6,208,343	03-2001	Roth, Steven William
• US-6,252,594	06-2001	Xia et al.
• US-6,476,831	11-2002	Wirth et al.
• US-6,583,795	06-2003	Ohyama, Yuhji

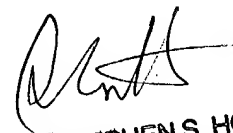
30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
August 17, 2004



STEPHEN S. HONG
PRIMARY EXAMINER